

Serial No.: 10/707,582
Attorney Docket No.: F-629

Patent

REMARKS

1. Status of Claims

Claims 1-20 were pending in the Application. Applicants have amended claims 1, 7, 9-13 and 20 and canceled claim 6 without prejudice or disclaimer. Applicants have added new claim 21. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-5 and 7-21 will remain pending in the application.

2. Rejections under 35 USC § 112

In section 8 of the Office Action, the Examiner rejected Claims 10 and 20 under 35 U.S.C. 112, second paragraph, as allegedly indefinite.

Applicants respectfully traverse the rejection and submit that the claims have been amended solely to make a cosmetic change to correct a typographical error.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 10 and 20.

3. Rejections under 35 USC § 103(a)

In section 11 of the Office Action, the Examiner rejected Claims 1, 11 and 13 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Published Patent Application 2003/0001020 A1 by Kardach ("Kardach '020") apparently in view of Official Notice.

Applicants respectfully traverse the rejection and requests a statement of exactly what is being taken as old and well known by official notice.

Furthermore, solely to expedite prosecution, Applicants have amended claims 1 and 13 and respectfully submit that the cited references do not render the amended claims obvious.

Serial No.: 10/707,582
Attorney Docket No.: F-629

Patent

Furthermore, solely to expedite prosecution, Applicants have amended claim 11. With respect to amended claim 11, Applicants respectfully submit that the cited references do not teach or fairly suggest:

scanning a digital pattern on each copy of the digital paper before printing a plurality of hardcopies and associating the plurality of hardcopies with the original electronic version of the document in a many to one association.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 1, 11 and 13.

In section 12 of the Office Action, the Examiner rejected Claims 2-4, 12 and 14-16 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Published Patent Application 2003/0001020 A1 by Kardach ("Kardach '020") in view of U.S. Published Patent Application 2002/0078088 A1 by Kuruoglu, et al. ("Kuruoglu '088").

Applicants respectfully traverse the rejection. Initially, Applicants respectfully submit that the references are not properly combined because Kardach '020 does not contemplate multiple users and therefore, one of skill in the art would not look to Kuruoglu for modifications.

Furthermore, Applicants respectfully submit that claims 1 and 13 have been amended and the rejection is moot. Applicants respectfully submit that the rejected claims are patentable over the cited references for at least the reasons described above with reference to claims 1 and 13.

Furthermore, solely to expedite prosecution, Applicants have amended claim 12. With respect to amended claim 12, Applicants respectfully submit that the cited references do not teach or fairly suggest:

comparing the annotation time metadata against a reviewer profile, wherein the reviewer profile includes relative and/or absolute expected annotation time data.

Claims 14-16 are patentable over the cited references for at least the same reasons discussed with reference to claims 2-4.

Serial No.: 10/707,582
Attorney Docket No.: F-629

Patent

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 2-4, 12 and 14-16.

In section 13 of the Office Action, the Examiner rejected Claims 5-6 and 17 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Published Patent Application 2003/0001020 A1 by Kardach ("Kardach '020") in view of U.S. Published Patent Application 2004/0205545 A1 by Bargeron, et al. ("Bargeron '545").

Applicants respectfully traverse the rejection. Initially, Applicants respectfully submit that the references are not properly combined because Kardach '020 does not contemplate multiple users and therefore, one of skill in the art would not look to Bargeron for modifications.

Furthermore, Applicants respectfully submit that claims 1 and 13 have been amended and the rejection is moot. Applicants respectfully submit that the rejected claims are patentable over the cited references for at least the reasons described above with reference to claims 1 and 13.

Furthermore, Applicants have canceled claim 6 and that rejection is moot.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 5 and 17.

In section 14 of the Office Action, the Examiner rejected Claims 7, 9 and 18 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Published Patent Application 2003/0001020 A1 by Kardach ("Kardach '020") in view of U.S. Published Patent Application 2002/0054778 A1 by Ericson, et al. ("Ericson '778").

Applicants note that the rejection stated U.S. Published Patent Application 2004/0205545 A1, but apparently refers to U.S. Published Patent Application 2002/0054778 A1.

Applicants respectfully traverse the rejection. Furthermore, Applicants respectfully submit that claims 1 and 13 have been amended and the rejection is moot. Applicants respectfully submit that the rejected claims are patentable over the

Serial No.: 10/707,582
Attorney Docket No.: F-629

Patent

cited references for at least the reasons described above with reference to claims 1 and 13.

Furthermore, solely to expedite prosecution, Applicants have amended claim 9. With respect to amended claim 9, Applicants respectfully submit that the cited references do not teach or fairly suggest:

wherein, the at least one editing command is a plurality of editing commands received from a plurality of team members; and further including:

prioritizing the editing commands using an authorization level associated with at least one of the team members.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 7, 9 and 18.

In section 15 of the Office Action, the Examiner rejected Claims 8, 10, 19 and 20 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Published Patent Application 2003/0001020 A1 by Kardach ("Kardach '020") in view of U.S. Published Patent Application 2002/0054778 A1 by Ericson, et al. ("Ericson '778") and in further view of U.S. Patent No. 5,581,682 to Anderson, et al. ("Anderson '682").

Applicants note that the rejection stated U.S. Published Patent Application 2004/0205545 A1, but apparently refers to U.S. Published Patent Application 2002/0054778 A1.

Applicants respectfully traverse the rejection. Furthermore, Applicants respectfully submit that claims 1 and 13 have been amended and the rejection is moot. Applicants respectfully submit that the rejected claims are patentable over the cited references for at least the reasons described above with reference to claims 1 and 13.

Furthermore, Applicants respectfully submit that the Examiner has failed to establish a prima facie rejection as there is no teaching or suggestion in the cited references regarding converting an editing command to an annotation.

Serial No.: 10/707,582
Attorney Docket No.: F-629

Patent

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 8, 10, 19 and 20.

4. New Claims

Applicants have added new claim 21 and respectfully submit that the new claims are patentable over the cited references.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection and submit that the invention as presently claimed in claims 1-5 and 7-21 is patentable and in condition for allowance.

5. Conclusion Of Remarks

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

6. Authorization

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-629.

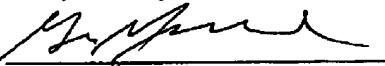
In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time

Serial No.: 10/707,582
Attorney Docket No.: F-629

Patent

or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit
Account Number 16-1885, Order No. F-629.

Respectfully submitted,



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- 15 -

3/3/06 Amendment